



AF
Xerox Docket No.D/98003 2673

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of

David GOLDBERG et al.

On Appeal from Group: 2673

Application No.: 09/682,333

Examiner: L. Lao

Filed: August 21, 2001

Docket No.: 105864

For: MANIPULATIVE USER INTERFACE SYSTEMS AND METHODS

RECEIVED

MAY 20 2004

Technology Center 2600

APPEAL BRIEF TRANSMITTAL

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

- Attached hereto are three (3) copies of our Brief on Appeal in the above-identified application.

The Commissioner is hereby authorized to charge Deposit Account No. 24-0037 in the amount of Three Hundred Thirty Dollars (\$330.00) in payment of the Brief fee under 37 C.F.R. 1.17(f). In the event of any underpayment or overpayment, please debit or credit our Deposit Account No. 24-0037 as needed in order to effect proper filing of this Brief.

For the convenience of the Finance Division, two additional copies of this transmittal letter are attached.

Respectfully submitted,

James A. Oliff
Registration No. 27,075

Klifton L. Kime
Registration No. 42,733

JAO:KLK/kzb
Date: May 17, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

**DEPOSIT ACCOUNT USE
AUTHORIZATION**
Please grant any extension
necessary for entry;
Charge any fee due to our
Deposit Account No. 24-0037



#18/appeal
Breyer
Soto/Oy
Knull
PATENT APPLICATION

THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE HONORABLE BOARD OF PATENT APPEALS AND INTERFERENCES

In re the Application of:

David GOLDBERG et al.

Application No.: 09/682,333

Filed: August 21, 2001

Docket No.: 105864

For: MANIPULATIVE USER INTERFACE SYSTEMS AND METHODS

RECEIVED

MAY 20 2004

Technology Center 2600

BRIEF ON APPEAL

05/18/2004 HDEMESS1 00000082 240037 09682333

01 FC:1402 330.00 DA

Appeal from Group 2673

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400
Attorneys for Appellants



TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
A. Real Party In Interest.....	1
B. Related Appeals and Interferences.....	1
C. Status of Claims	1
D. Status of Amendments	1
II. SUMMARY OF THE INVENTION AND APPLIED REFERENCES	1
A. The Invention	1
B. The Rejections	3
C. The Applied References.....	4
III. THE ISSUES ON APPEAL.....	4
IV. GROUPING OF THE CLAIMS ON APPEAL	5
V. LAW	5
A. 35 U.S.C. §102 (Anticipation)	5
B. 35 U.S.C. §103(a) (Obviousness)	6
VI. ARGUMENTS.....	8
A. Claims 1-3 and 5-7 Are Not Anticipated By Shintani	8
B. Claims 4 and 8-10 Are Not Rendered Obvious By Shintani and Woolston.....	12
C. Claim 11 Is Not Rendered Obvious By Shintani and Gershon.....	13
CONCLUSION.....	15
APPENDIX A.....	A-1

RECEIVED

MAY 20 2004

Technology Center 2600



I. INTRODUCTION

This is an Appeal from a final Office Action mailed January 2, 2004 finally rejecting claims 1-11. No claims are allowed.

RECEIVED

MAY 20 2004

Technology Center 2600

A. Real Party In Interest

The real party in interest for this Appeal is Xerox Corporation, by way of an Assignment recorded at Reel 011882, Frame 0478.

B. Related Appeals and Interferences

There are presently no appeals or interferences, known to Appellants, Appellants' representative or the Assignee, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

C. Status of Claims

Claims 1-11 are pending. Claims 1-11 stand finally rejected and are on appeal. Of the claims that are on appeal, claims 1, 3 and 6 are independent. Claims 2 and 11 depend directly from claim 1. Claims 4 and 5 depend directly from claim 3. Claims 7-10 depend directly or indirectly from claim 6. Claims 1-11 are set forth in the attached Appendix.

D. Status of Amendments

The Amendment After Final Rejection filed on September 8, 2003, was entered. The Amendment After Final Rejection amended claims 1-9 and added claim 11. No subsequent Amendments have been filed.

II. SUMMARY OF THE INVENTION AND APPLIED REFERENCES

A. The Invention

The present invention relates to reification of virtual concepts into physical devices having manipulative user interfaces. (Page 1, lines 4-5.) In various exemplary embodiments, the systems and methods according to the invention take two previously virtual concepts, the concept of "a user" and the concept of "the user's data" and treats these virtual concepts as

physical objects. Such embodiments reify these two virtual concepts as physical objects which can contain state, such as, for example, status information about "the user," and which can be physically manipulated. In various exemplary embodiments, the systems and methods according to this invention focus on the interaction between such physically reified data about the user, such as, for example, status information about the user, and legacy technologies such as, for example, desktop or portable computers. (Page 1, line 26 - page 2, line 2.)

In various exemplary embodiments, the systems and methods of this invention allow an individual user (i.e. " the user") to control a process in one physical device, such as, for example, a computer, by physically manipulating one or more other physical devices, such as, for example, a representation or reification of that "user." (Page 2, lines 3-7.)

In various exemplary embodiments, the systems and methods of this invention also allow an individual user (i.e. " the user") to control one or more processes or functions in one or more first physical devices, such as, for example, one or more computers, by changing the location or placement of one or more second "reified" physical devices relative to the first physical device, such as, for example, the placement of a second physical device on the computer case. (Page 2, lines 8-13.)

The manipulative user interface (MUI) according to this invention includes at least two devices, in which a first device uses a manipulative user interface to control its interaction with another device when the first device is brought next to, or taken away from, the other device, which may or may not itself have a manipulative user interface. (Page 2, lines 14-18.)

In embodiments, a physically manipulatable (reified) device (bear 100, Figs. 1 and 2) has information about the user, such as a password, stored therein. (Page 4, lines 11-28.) An interface between the physically manipulatable (reified) device and a responsive device, such

as a computer (computer 200, Fig. 2), that allows at least some of the stored information about the user to be transferred/communicated from the physically manipulatable (reified) device to the responsive device. For example, the password stored in the physically manipulatable (reified) device (bear 100, Figs. 1 and 2) may be communicated to the computer (computer 200, Fig. 2) to log the user into the computer. (Page 4, lines 11-28.) In embodiments, an object, such as a hat (hat 120, Figs. 1 and 2) may be placed relative to the physically manipulatable (reified) device (bear 100, Figs. 1 and 2) to communicate at least some of the stored information about the user to the responsive device. (Page 5, lines 6-18.)

B. The Rejections

The final Office Action rejects claims 1-3 and 5-7 under 35 U.S.C. §102(b) over U.S. Patent No. 5,841,868 to Helbig, Sr. (hereinafter, "Helbig"). However, as indicated by the Examiner during a telephone interview on February 18, 2004, as stated in the corresponding Interview Summary mailed on February 19, 2004, and as stated in the Advisory Action mailed on March 22, 2004, the rejection based on Helbig will be withdrawn. Accordingly, Appellants understand that the rejection of claims 1-3 and 5-7 under 35 U.S.C. §102(b) over Helbig is withdrawn and is not at issue on appeal.

The final Office Action rejects claims 1-3 and 5-7 under 35 U.S.C. §102(e) over U.S. Patent No. 6,137,480 to Shintani (hereinafter, "Shintani").

The final Office Action rejects claims 4 and 8-10 under 35 U.S.C. §103(a) over Helbig or Shintani in view of U.S. Patent No. 5,845,265 to Woolston (hereinafter, "Woolston"). Appellants understand that the portion of this rejection that is based on Helbig also is withdrawn and is not at issue on appeal, for the reason discussed above.

The final Office Action rejects claim 11 under 35 U.S.C. §103(a) over Shintani in view of U.S. Patent No. 6,257,984 to Gershon (hereinafter, "Gershon").

C. The Applied References

Shintani discloses, in Fig. 1, for example, a computer terminal 1 constituted by a keyboard 3 and a display 4. (Col. 2, lns. 29-30.) In addition to the computer terminal 1, the computer system of Shintani includes a portable non-contact card 2. (Col. 2, lns. 24-26.)

Various personal identification information is written to a non-volatile memory 13 of the non-contact card 2. (Col. 2, lns. 32-44.) A communication section 14 is provided to the keyboard 3 for communicating with the non-contact card 2. (Col. 2, lns. 45-47.) According to Shintani, when the communication section 14 detects the non-contact card 2, personal identification information stored in the non-contact card 2 is transmitted to the communication section 14 of the keyboard 3, and then is supplied to the body of the computer 1. The computer 1 then authenticates a user based on the supplied information. (Col. 2, lns. 61-66.) A user table that includes the personal identification information is stored in the computer 1 and is used by the computer 1 to authenticate the personal identification information received from the non-contact card 2. (Col. 2, ln. 66 - col. 3, ln. 17.)

Woolston discloses a method and apparatus for creating a computerized market. (Abstract.) According to Woolston, a get log response 104 may retrieve information, such as a credit card number, a pin number, a user ID and the like, to grant access privileges to a participant. (Col. 9, lns. 11-15.)

Gershon discloses a push button-operated video game 34 mounted in a front display position of a cap 24. (Abstract; Figs. 3 and 5.) Gershon further discloses a cap 10 having a front area 16 which holds a display 18 consisting of a frame 20 and a card 22. (Col. 1, lns. 58-62; Fig. 1.)

III. THE ISSUES ON APPEAL

The issues on appeal are:

1. Whether, under 35 U.S.C. §102(e), claims 1-3 and 5-7 are anticipated by Shintani;
2. Whether, under 35 U.S.C. §103(a), claims 4 and 8-10 are rendered obvious by the combination of Shintani and Woolston; and
3. Whether, under 35 U.S.C. §103(a), claim 11 is rendered obvious by the combination of Shintani and Gershon.

IV. GROUPING OF THE CLAIMS ON APPEAL

Each claim of this patent application on appeal is separately patentable, and upon issuance of a patent will be entitled to a separate presumption of validity under 35 U.S.C. §282. For convenience in handling of this appeal, the claims are grouped as follows:

- Group I: Claims 1-2 and 11;
- Group II: Claims 3-4;
- Group III: Claims 5-10.

Each of Groups I-III are argued separately in the following arguments. The Groups do not stand or fall together.

V. LAW

A. 35 U.S.C. §102 (Anticipation)

In order to be anticipatory under 35 U.S.C. §102, an applied reference must have each and every feature set forth in the claims.

It is well settled that the burden of establishing a prima facie case of anticipation resides with the Patent and Trademark Office (PTO). See In re Piasecki, 745 F.2d 1468, 223 USPQ 785, 788 (Fed. Cir. 1984). "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See also, Atlas Powder Co. v. IRECO Inc., 190 F.3d 1342,

1346, 51 USPQ2d 1943, 1945-46 (Fed. Cir. 1999); In re Schreiber, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997); In re Paulsen, 30 F.3d 1475, 1478, 1479, 31 USPQ2d 1671, 1675 (Fed. Cir. 1994); In re Spada, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); Hazani v. Int'l Trade Comm'n, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997); and RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

All words in a claim must be considered in judging the patentability of that claim against the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

B. 35 U.S.C. §103(a) (Obviousness)

In rejecting claims under 35 U.S.C. 103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), including: (A) determining the scope and content of the prior art; (B) ascertaining the differences between the prior art and the claims in issue; (C) resolving the level of ordinary skill in the pertinent art; and (D) evaluating evidence of secondary considerations.

In rejecting claims, the Patent Office bears the initial burden of persuasion in establishing a *prima facie* case of obviousness. To achieve this, the Patent Office must show three criteria: a suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings; a reasonable expectation of success; and that the prior art must teach or suggest all claimed limitations. See In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See also MPEP §2143.

Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not “evidence.” See Dembiczak, 175 F.3d at 1000, 50 USPQ2d at 1617. However, the suggestion to combine need not be express and “may come from the prior art, as filtered through the knowledge of one skilled in the art.” Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997).

It is impermissible for an Examiner to engage in hindsight reconstruction of the claimed invention using appellant’s structure as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the appellant’s combination would have been obvious. In re Gorman, 911 F.2d 982, 986, 18

USPQ2d 1885, 1888 (Fed. Cir. 1991). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

VI. ARGUMENTS

A. Claims 1-3 and 5-7 Are Not Anticipated By Shintani

The final Office Action rejects claims 1-3 and 5-7 under 35 U.S.C. §102(e) over Shintani. This rejection is improper and should be reversed.

Independent claim 1 of Group I recites *inter alia* "A method of transferring information about a user of a responsive object to that responsive object, comprising: storing information about the user in a physically manipulatable device . . . placing an object relative to the physically manipulatable device . . . wherein relatively placing the object and the physically manipulatable device . . . communicates at least some of the stored information about the user to the responsive device." Shintani fails to disclose, teach or suggest "storing information about the user in a physically manipulatable device," as recited in claim 1.

The final Office Action identifies the keyboard 3 disclosed by Shintani as allegedly being "a physically manipulatable reified device." Further, the final Office Action identifies the computer 1 and display 4 disclosed by Shintani as allegedly being "a responsive device."

The rejection explicitly alleges that "relatively placing the object (34) and the physically manipulatable reified device and/or physically manipulating the object communicates at least some of stored information about the user (authorization user) to the responsive device," referring to Figs. 1-3, col. 2, line 24 - col. 3, line 48.

However, the final Office Action fails to explain how the alleged "physically manipulatable device" (keyboard 3) stores information about a user. The Advisory Action

mailed on March 22, 2004, alleged that "the keyboard (3) temporarily stored the ID code transmitted from the card (2)," referring to Figs. 1-3, col. 2, line 61 - col. 3, line 10.

Appellants respectfully submit that nothing in Shintani supports this allegation.

Shintani does not disclose anywhere that any information transmitted from the non-contact card 2 is "temporarily stored" by the keyboard 3. On the contrary, Shintani only discloses that "personal identification information stored in the non-contact card 2 is transmitted to the communication section 14, is supplied to the body of the computer via the cable 15 and to [sic] the display 4." Appellants respectfully submit that such transmission of information from the card 2 to the computer 1 via the communication section 14 of the keyboard 3 does not require the information to be "temporarily stored" by the keyboard 3, as alleged. On the contrary, transmission via the keyboard 3 may be accomplished without any storage, such as with a relay antenna. Shintani does not disclose that the communications section 14 or any other portion of the keyboard 3 has any means for storing information, such as memory or the like.

Therefore, while the keyboard 3 may be physically manipulated, there is no disclosure in Shintani of storing information about the user in the keyboard 3. Therefore, Shintani fails to disclose the step of storing information about the user in a physically manipulatable device, as recited in claim 1. Further, because no information is stored in the alleged "physically manipulatable device" (keyboard 3), Shintani cannot teach that "relatively placing the object and the physically manipulatable device . . . communicates at least some of the stored information about the user to the responsive device," as recited in claim 1 (emphasis added).

Thus, independent claim 1 is not anticipated by Shintani. Claim 2 is not anticipated at least in view of the above limitations of claim 1 from which it depends, as well as for the additional features it recites.

Independent claim 3 of Group II recites *inter alia* "storing information about the user in a physically manipulatable reified device." As argued above with respect to claim 1, Shintani fails to disclose, teach or suggest storing information about the user in a physically manipulatable device. Further, Appellants respectfully submit that the keyboard 3 is not a reified device as recited in claim 3.

Reification is a process by which concepts are turned into objects. For example, in a graphical editing tool, the concept of a circle is represented as an image of a circle in a tool palette. In other words, the concept of a circle is reified into a tool. Reification creates new objects that can be manipulated by the user. Shintani is totally devoid of any disclosure or suggestion of reification or turning concepts into objects, and the keyboard 3 is not disclosed as a reified device.

The final Office Action states that the keyboard is a reified device without providing any support for the allegation. By failing to provide any support, Appellants respectfully submit that the final Office Action effectively ignores this term in rejecting claim 3. Since every term recited in a claim must be considered in judging the patentability of that claim (In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)), the rejection is improper.

At least for these reasons, independent claim 3 is not anticipated by Shintani.

Independent claims 5 and 7 of Group III each recite *inter alia* "A reified device for interfacing and communicating with a computer . . . comprising . . . at least one physically manipulatable element to store information about the user." Shintani fails to disclose, teach or suggest these claimed features.

Shintani fails to disclose, teach or suggest a reified device at all. The only device alleged to be "reified" in the rejection stated by the final Office Action is the keyboard 3 of

Shintani. However, as discussed above with respect to claim 3, the keyboard 3 is not a reified device. Not only is Shintani totally devoid of any disclosure or suggestion of reification or turning concepts into objects, no device disclosed by Shintani is a reified device. Thus, Appellants respectfully submit that there is no device in Shintani that can reasonably be considered to anticipate a reified device as recited in claims 5 and 7.

Furthermore, because Shintani fails to disclose, teach or suggest storing information about the user in a physically manipulatable device, as argued above with respect to claim 1, Appellants respectfully submit that Shintani does not disclose a physically manipulatable element to store information about the user, as recited in claims 5 and 7. The only elements disclosed by Shintani to store information about the user are the non-contact card 2 and the computer 1. However, neither the non-contact card 2 nor the computer 1 is disclosed as being physically manipulatable.

At least for these reasons, independent claims 5 and 7 are not anticipated by Shintani. Claim 6 is not anticipated at least in view of the above limitations of claim 5 from which it depends, as well as for the additional features it recites.

Accordingly, for the reasons discussed above, it is respectfully submitted the rejection of claims 1-3 and 5-7 under 35 U.S.C. §102(e) over Shintani is improper and should be reversed.

During the February 18, 2004, telephone interview, the Examiner clarified her position from that stated in the final Office Action. In particular, the Examiner explained that, in Shintani, the keyboard 3 is considered to be part of the computer 1 which is considered to store an ID/code to compare with the user information from the non-contact card 2. As this basis for rejecting the claims over Shintani is not stated in the final Office Action, Appellants do not consider this position to have been properly stated on the record to

be at issue on appeal. Should the Examiner choose to restate her position in her answer to this Appeal Brief, Appellants will respond accordingly.

B. Claims 4 and 8-10 Are Not Rendered Obvious By Shintani and Woolston

The final Office Action rejects claims 4 and 8-10 under 35 U.S.C. §103(a) over Shintani in view of Woolston. This rejection is improper and should be reversed.

Appellants respectfully submit that claim 4 of Group II is patentable over the asserted combination of Shintani and Woolston at least in view of the patentability of claim 3 from which it depends. As discussed above, Shintani fails to disclose, teach or suggest "storing information about the user in a physically manipulatable reified device" as recited in claim 3.

The final Office Action cites Woolston only for the alleged disclosure of a credit card number being used for identification of a user. This alleged disclosure does not make up for the deficiencies of Shintani with respect to claim 3 discussed above. Therefore, the asserted combination of Shintani and Woolston does not disclose, teach or suggest every feature recited in claim 4. Thus, claim 4 is patentable over the asserted combination of Shintani and Woolston.

Appellants respectfully submit that claims 8-10 of Group III are patentable over the asserted combination of Shintani and Woolston at least in view of the patentability of claim 7 from which they depend. As discussed above, Shintani fails to disclose, teach or suggest a reified device at all. Further, as discussed above, Shintani fails to disclose, teach or suggest a physically manipulatable element to store information about the user, as recited in claim 7.

The alleged disclosure of Woolston relied upon in the final Office Action does not make up for the deficiencies of Shintani with respect to claim 7 discussed above. Therefore, the asserted combination of Shintani and Woolston does not disclose, teach or suggest every

feature recited in claims 8-10. Thus, claims 8-10 are patentable over the asserted combination of Shintani and Woolston.

Accordingly, for the reasons discussed above, it is respectfully submitted the rejection of claims 4 and 8-10 under 35 U.S.C. §103(a) over Shintani in view of Woolston is improper and should be reversed.

C. Claim 11 Is Not Rendered Obvious By Shintani and Gershon

The final Office Action rejects claim 11 under 35 U.S.C. §103(a) over Shintani in view of Gershon. This rejection is improper and should be reversed.

The final Office Action admits that Shintani fails to disclose the object (non-contact card 2) is a hat. The Office Action attempts to overcome this deficiency by combining Gershon with Shintani. Appellants respectfully submit that the asserted combination is improper.

The asserted combination of Gershon with Shintani appears to be based on impermissible hindsight. The alleged motivation to combine, "so as to provide avoid loss and damage," bears no relationship to the modification of Shintani required to achieve the features recited in claim 11.

Gershon teaches that a card 22 may be inserted into a frame 20 as part of a display 18 on a front area 16 of a hat 10. The card 22 according to Gershon is for display and is inserted into the frame 20, for example, to obviate loss and damage to the card 22. Appellant respectfully submit that such a display card may be a collecting or trading card (e.g., baseball card) that a youth may wish to display while protecting the card from loss or damage.

However, the card 22 disclosed by Gershon is not a hat. The card 22 may be inserted into the frame 20 for display. Gershon's disclosure of storing a card in a display portion of a cap does not suggest to a person of ordinary skill in the art that the card could be a hat, let alone teach one skilled in the art to modify Shintani's non-contact card to be a hat.

On the contrary, Appellants respectfully submit that the asserted combination is the result of impermissible hindsight using Appellant claims as a roadmap to locate features missing from the primary reference. Moreover, the modification alleged by the final Office Action would not result from the teachings of the references. On the contrary, Appellants respectfully submit that the non-contact card of Shintani would be inserted and temporarily stored in the frame of the cap of Gershon. This would not result in the object, the non-contact card, being a hat, as recited in claim 11. As such the asserted combination, the proposed modification, and the rejection based thereon are improper.

Further, even if the combination of Gershon and Shintani were proper, Appellants respectfully submit that claim 11 of Group III is patentable over the asserted combination of Shintani and Gershon at least in view of the patentability of claim 1 from which it depends. As discussed above, Shintani fails to disclose, teach or suggest "storing information about the user in a physically manipulatable device" as recited in claim 1.

The final Office Action cites Gershon only for the alleged disclosure of a card mounted on a hat. This alleged disclosure does not make up for the deficiencies of Shintani with respect to claim 1 discussed above. Therefore, the asserted combination of Shintani and Gershon does not disclose, teach or suggest every feature recited in claim 11. Thus, claim 11 is patentable over the asserted combination of Shintani and Gershon.

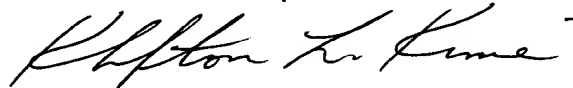
Accordingly, it is respectfully submitted the rejection of claim 11 under 35 U.S.C. §103(a) over Shintani in view of Gershon is improper and should be reversed.

CONCLUSION

The rejections set forth in the final Office Action should be reversed, at least for the reasons set forth above.

The Honorable Board is requested to reverse the rejections set forth in the Final Rejection and to pass this application to issuance.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Klifton L. Kime
Registration No. 42,733

JAO:KLK/hs

Attachment:
Appendix A

Date: May 17, 2004

OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

<p>DEPOSIT ACCOUNT USE AUTHORIZATION Please grant any extension necessary for entry; Charge any fee due to our Deposit Account No. 15-0461</p>
--

APPENDIX A

CLAIMS:

1. A method of transferring information about a user of a responsive object to that responsive object, comprising:
 - storing information about the user in a physically manipulatable device;
 - providing a manipulative user interface between the responsive device and the physically manipulative device;
 - placing an object relative to the physically manipulatable device;
 - wherein relatively placing the object and the physically manipulatable device and/or physically manipulating the object communicates at least some of the stored information about the user to the responsive device .
2. The method of claim 1, wherein the communicated stored information comprises the level of authority of the user .
3. A method of transferring information about a user of a responsive object to that responsive object, comprising:
 - storing information about the user in a physically manipulatable reified device;
 - providing a manipulative user interface between the responsive device and the physically manipulative device
 - placing an object relative to the physically manipulatable reified device;
 - wherein relatively placing the object with respect to the physically manipulatable reified device and/or physically manipulating the object communicates at least some of the stored information about the user to or from the responsive device.
4. The method of claim 3, wherein the communicated stored information comprises an asset of the user .

5. A reified device for interfacing and communicating with a computer, comprising a physical representation of one user of the responsive device, the physical representation comprising:

a manipulatable user interface to communicate with the responsive device;
at least one physically manipulatable element to store information about the user;
an object placed relative to the physically manipulatable element; and
the object being so placed and/or physically manipulated to activate the user manipulatable user interface to communicate with the responsive device.

6. The reified device of claim 5, where the communicated stored information includes the level of authority of the user .

7. A reified device for interfacing and communicating with a computer, comprising a physical representation of a user of the responsive device, the physical representation comprising:

a manipulatable user interface to communicate with the responsive device;
an object placed relative to the manipulatable user interface; and
at least one physically manipulatable element to store information about the user;
the object being so placed and/or physically manipulated to activate the manipulatable user interface to communicate with the responsive device.

8. The reified device of claim 7, wherein the communicated stored information comprises an asset of the user .

9. The reified device of claim 8, wherein the asset is a credit card number.

10. The reified device of claim 9, wherein the object used to manipulate the reified device is an object that can be placed into at least one predefined relationship to reified device.

11. The method of claim 1, wherein the object is a hat.